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09/973,273	10/09/2001	Nick Nassiri		5689

7590 10/03/2007  
Nicholas N. Nassiri  
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EXAMINER
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HENEGHAN, MATTHEW E

ART UNIT	PAPER NUMBER
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2134

MAIL DATE	DELIVERY MODE
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10/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/973,273

Applicant(s)

NASSIRI, NICK

Examiner

Matthew Heneghan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 24 July 2007 has been entered.
2. Several amendments were submitted between the mailing of the first office action on 29 June 2005 and the submission of the most recent amendment on 24 July 2007. Because these proposed amendments were found to be non-compliant and/or non-responsive, the amendments to the specification and claims have not been entered and are not being considered.
3. In response to the initial first office action, Applicant has amended claims 1, 24, and 51. Claims 1-77 have been examined.

### ***Drawings***

4. The drawings were received on 10 April 2007. These drawings are not acceptable.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because none of the reference characters are mentioned in the description.
6. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

7. Claims 1, 24, and 51 are objected to because of the following informalities: Each claim teaches to both a method and a system on which that method is performed. Claims may teach to a method or a system, but not both. For purposes of the prior art

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search, it is being presumed that the claims only teach to the claimed method, and limitations teaching solely to the system's structure are being considered to be part of the preamble. Consequently, dependent claims that only further define the system's structure in a manner that does not affect the scope of the claimed methods (i.e. claims 2, 4, 10-23, 25, 27, 30, 33-49, 52, 55, 61-68, and 70-77) shall stand or fall with their respective parent claims.

Appropriate correction is required.

8. Claims 1, 6, 24, 29, 51, and 57 are objected to because of the following informalities: The documents produced by each method are defined in the specification as possibly not being tangible. Though the claimed methods do encompass statutory subject matter under 35 U.S.C. 101, intangible documents produced by the process would not. It is requested that, in order to remove any confusion about the scope of the claims, the property of intangibility of the documents be removed from the specification and the claims. For purposes of the prior art search, claims 6, 29, and 57 stand or fall with their parent claims.

Appropriate correction is required.

9. Claims 1, 24, and 51 are objected to because of the following informalities: In to next to last limitation of each claim, the host computer server uploads a document to itself. It is being presumed that the document is being uploaded to the VVSC.

Appropriate correction is required.

10. Claim 26 is objected to because of the following informalities: It claims "The method of claim 24 of claim 24..." on the first line.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101 and § 112***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 9, 32, and 60 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: The method by which personal genetic information is reducible to genetic code. For purposes of the prior art search, this phrase is being treated as too vague and is being ignored.

12. Claims 7, 8, 31, 58, and 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 7 and 58, the phrases "may be" and "such as" render the claim indefinite because it is unclear whether the limitations following the phrases are part of the claimed invention. See MPEP § 2173.05(d).

Claims 7 and 58 also provides for the use of the document in banking, real estate, and law, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced. For purposes of the prior art search, claim 7 stand or falls with parent claim 1.

Regarding claim 8, 31, and 59, the phrase "including" renders the claim indefinite because it is unclear whether the limitations following the phrases are part of the claimed invention. See MPEP § 2173.05(d). It is being presumed that any type of electronic signature teaches to claim 8.

13. Claims 7 and 58 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2001/0002485 to Bisbee et al. in view of U.S. Patent No. 5,712,914 to Aucsmith further in view of U.S. Patent No. 6,317,777 to Skarbo et al.

Bisbee discloses a system wherein a set of parties (signatories) in a networked architecture, using Transfer Agents, use a server, a Document Authentication System (DAS), in conjunction with a notary, called a TCU. Electronic documents are transmitted to the TCU via a communication means (see paragraph 69). The Transfer Agent relays to the TCU a set of verification data, including digitized hand-written signatures, biometric information, and a digital signature (certificate), which have been acquired by the transfer agent from the appropriate means (see paragraph 70).

Upon verification of the information provided by the transfer agents, the TCU appends a certificate to the document to confirm authenticity, but does not append the biometric data, or certificates supplied by the Transfer Agents.

Aucsmith discloses certificate extensions including logos, handwritten signatures, and biometric data, and states that these verify that the signers are really who they say



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they are (see column 5, line 40 to column 9, line 47). Any additional data derived by this process would constitute a digital signature.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Bisbee by appending the logos, handwritten signatures, and biometric data to the certificates on produced documents, as disclosed by Aucsmith, to verify that the signers are really who they say they are.

Bisbee's TCU may be instructed to encrypt the produced document before distribution (see paragraph 71).

Bisbee also does not explicitly specify the means by which the users are transacting.

Skarbo discloses a document collaboration system via videoconferencing, via the web or otherwise, supervised by a document server (the VVSC) (see column 2, lines 40-62). Skarbo further suggests that this reliably gets conference data to conference participants (see column 1, lines 46-48).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to perform the contract negotiation via videoconference, via the web or otherwise, as disclosed by Skarbo, as this reliably gets conference data to conference participants.

Aucsmith also discloses the appending of retinal prints and hand geometry.

### ***Conclusion***

15. Applicant is invited to contact the Examiner for assistance with the drafting of claims, particularly to help overcome the several technical objections and rejections stated in this action. Contact information is listed below.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan, whose telephone number is (571) 272-3834. The examiner can normally be reached on Monday-Friday from 8:30 AM - 4:30 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand, can be reached at (571) 272-3811.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-3800

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Matthew Heneghan/

September 25, 2007

Patent Examiner (FSA), USPTO Art Unit 2134